

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MATTHEW A. HOWARD III, WILLIAM E. LA VELLE,  
MATTHEW B. DOBBS and TEREASA M. SIMONSON

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Appeal No. 1999-0212  
Application No. 08/230,526<sup>1</sup>

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ON BRIEF

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Before COHEN, ABRAMS and NASE, **Administrative Patent Judges**.

ABRAMS, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1, 4, 7-13, 15-18 and 21-23. Claims 2 and 3 have been canceled, and claims 5, 6, 14, 19 and 20 have been allowed.

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<sup>1</sup> Application for patent filed April 20, 1994.

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The appellants' invention is directed to a skull fiducial marker method and apparatus. The claims on appeal have been reproduced in an appendix to the Brief.

#### **THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Guthrie et al.	(Guthrie)	5,230,623	Jul. 27,
1993			
Gill		2 213 066 A	Sep. 8,
1989			
(UK Patent Application)			

#### **THE REJECTION**

Claims 1, 4, 7-13, 15-18 and 21-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guthrie in view of Gill.

#### **OPINION**

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejection, we make reference to the

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final rejection (Paper No. 19) and the Answer (Paper No. 22) for the reasoning in support of the rejections, and to the Appellants' Brief (Paper No. 21), for the arguments thereagainst.

The guidance provided us by our reviewing court for evaluating the issue of obviousness is as follows: The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a

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conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The appellants' invention is directed to a skull fiducial marker apparatus that is positioned on the patient solely by virtue of being held between the patient's teeth. As manifested in claim 1, the invention comprises a custom mouthpiece for attachment to the maxilla of a patient, a projection extending forward from the mouthpiece, a curved U-shaped bar removably connected to the projection and having

distal portions for receiving fiducial markers, and fiducial markers attachable to the bar. The examiner is of the view that all of the subject matter recited in claim 1 is taught by Guthrie, except for the removable connection of the U-shaped bar to the forward projection of the mouthpiece. However, it is the examiner's position that, in view of the teachings of Gill, one of ordinary skill in the art would have found it obvious to modify the Guthrie apparatus by removably connecting the U-shaped bar to the projection extending from the mouthpiece. The appellants dispute this conclusion on the basis that "[n]othing in the references teaches or suggests" five listed features of claim 1 (Brief, page 6), and that the references fail to show the required forwardly extending projection and teach away from the claimed removable connection (Brief, pages 9 and 10). We are not persuaded by these arguments that the position taken by the examiner is in error.

From our perspective, Figure 5 of Guthrie clearly shows all of the features of the invention except for the removable attachment of the U-shaped bar and the forward projection from the mouthpiece. With regard to the forward projection, we

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refer to the explanation beginning on line 45 of column 7 for the teaching that bite piece 550 has an impression of the patient's teeth, that is, a mouthpiece, at its inner end which is not shown in the drawing because it is within the patient's closed lips. This being the case, bite piece 550 constitutes "a projection extending forward of the mouthpiece," as required by claim 1. Insofar as the removable connection is concerned, Gill teaches that the mouthpiece can be removable from the remainder of the skull reference apparatus, from which one of ordinary skill in the art would have found it obvious to do so with respect to the Guthrie apparatus. Suggestion for such would have been found, in our view, in the self-evident advantages thereof, such as ease of manufacture of the custom mouthpiece obtained by having it removable from the other portions of the device and the ability to utilize these other portions with other mouthpieces, which would have been evident to one of ordinary skill in the art, because in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

The appellants argue that the statements in column 8 of Guthrie teach away from removable attachment of mouthpiece to frame. We do not agree, for as we interpret these passages, removal of the device from an intubated or sedated patient is facilitated not because the mouthpiece is permanently attached to the frame, but simply because it is attached in some fashion. Regarding the Gill device, it clearly is more complex than that of the appellants or Guthrie. The question is, however, whether Gill would have suggested to one of ordinary skill in the art making the mouthpiece removable from the frame in this type of device, which we answer in the affirmative.

It is our conclusion that the combined teachings of Guthrie and Gill establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 1, and we therefore will sustain the rejection.

The appellants have not provided arguments directed to the separate patentability of any of the other claims, but have merely listed the elements recited in each (Brief, pages 6-9), concluding with the statement that "Guthrie does not teach or suggest the claimed features" (Brief, page 9). This

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being the case, we shall consider claim 1 to be a  
representative claim, with all of the other claims falling  
therewith. See 37 CFR  
§ 1.192(c)(7).

**SUMMARY**

The rejection of claims 1, 4, 7-13, 15-18 and 21-23 is  
sustained.

The decision of the examiner is affirmed.

**AFFIRMED**

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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